The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

#### UNITED STATES PATENT AND TRADEMARK OFFICE

# BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TADASHI TAKANO, HIDEAKI TAKAHASHI and SUSUMU ANDO

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U.S. PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES Appeal No. 2005-1556 Application No. 09/683,286

HEARD: October 19, 2005

Before NASE, CRAWFORD, and BAHR, <u>Administrative Patent Judges</u>. BAHR, <u>Administrative Patent Judge</u>.

### **DECISION ON APPEAL**

The appellants originally appealed from the examiner's rejection of claims 1, 2, 4, 5, 7, 9, 11, 13 and 14. At the oral hearing, appellants' counsel, Ernest A. Beutler, withdrew claims 1, 2, 13 and 14 from appeal, 1 conceding that these claims are anticipated by U.S. Patent No. 4,752,707 issued to Wayne J. Morrill on June 21, 1988<sup>2</sup>. Accordingly, this appeal involves only claims 4, 5, 7, 9 and 11.

<sup>&</sup>lt;sup>1</sup> These claims will be cancelled by the examiner in accordance with Manual of Patent Examining Procedure (MPEP) Section 1214.05 upon return of the application to the examiner.

<sup>&</sup>lt;sup>2</sup> This reference has not been applied by the examiner in any rejection of any of the claims on appeal. It was cited by the appellants in an information disclosure statement filed October 31, 2003.

Application No. 09/683,286

#### **BACKGROUND**

The appellants' invention relates to a rotating electrical machine of the type that employs permanent magnets and cooperating coil windings wound around armature cores in confronting relationship to the permanent magnets (appellants' specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

#### The Applied Prior Art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Konecny	4,774,428	Sep. 27, 1988
Kordik	5,107,159	Apr. 21, 1992
Kondo et al. (Kondo)	5,900,687	May 4, 1999
Suzuki et al. (Suzuki)	6,081,058	Jun. 27, 2000

#### The Rejections

Claims 4, 5, 7, 9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Konecny in view of Kondo, Kordik and Suzuki.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

Appeal No. 2005-1556 Application No. 09/683,286

(mailed October 22, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed August 12, 2003) for the appellants' arguments thereagainst.

#### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 4 calls for all of the permanent magnets to be of "substantially the same shape" and for a circumferential offset angle of each permanent magnet from a regularly disposed position (i.e., the magnets are not all equally spaced; see specification, pages 8 and 9). The examiner concedes that Konecny does not disclose the recited circumferential offset angle feature and relies on Suzuki for a suggestion to provide such an offset angle. We, however, find no disclosure in Suzuki of a circumferential offset of the magnets from a regularly disposed position and the portions of the disclosure (Figures 5 and 6 and column 4) referred to by the examiner appear to be directed to the angular extent of the groove portion of the magnets, not to a circumferential offset from a regularly disposed position. Nor does the examiner's

Application No. 09/683,286

application of Kondo or Kordik make up for this shortcoming. We therefore cannot sustain the rejection of claim 4 or claims 7, 9 and 11 depending from claim 4.

We also cannot sustain the rejection of claim 5, which depends from claim 2 and further recites that the magnitude of the torque exerted on each permanent magnet is determined separately by a computer numerical analysis and peaks or bottoms of the torque curves of said permanent magnets are offset from each other with respect to the rotation angle of the rotor so that the cogging number is increased. Konecny provides no disclosure from which to conclude that the rotating machine of Figure 2 therein inherently meets this torque limitation. As for a suggestion to modify Konecny so as to meet this limitation, the examiner simply points out that "discovering an optimum value of a result effective variable involves only routine skill in the art" (answer, page 7). The examiner has not, however, set forth any evidentiary basis establishing that the torque curves offset was recognized as a result effective variable by those of ordinary skill in the art at the time of the appellants' invention and has thus failed to set forth a *prima facie* case of obviousness of the claimed subject matter.

Application No. 09/683,286

## **CONCLUSION**

To summarize, claims 1, 2, 13 and 14 have been withdrawn from appeal and the decision of the examiner to reject claims 4, 5, 7, 9 and 11 is reversed.

#### REVERSED

JEFFREY V. NASE

Administrative Patent Judge

MURRIEL E. CRAWFORD

Administrative Patent Judge

JENNIFER D. BAHR

Administrative Patent Judge

BOARD OF PATENT APPEALS

AND

**INTERFERENCES** 

Appeal No. 2005-1556 Application No. 09/683,286

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